

Appl. No. 09/778,375
Atty. Docket No. 8414Q
Amdt. dated March 31, 2005
Reply to Office Action of Jan. 5, 2005
Customer No. 27752

REMARKS

Claim Status

Claims 1 and 10 - 16 are pending in the present application. Claims 1, 10-11, and 14-16 are rejected under 35 U.S.C. § 103. Claims 12-13 are indicated as allowable, but are objected to as depending from a rejected base claim.

Rejection Under 35 USC §103(a) Over Robinson

Claim 1 is rejected under 35 U.S.C. § 103 as unpatentable over Robinson (WO 98/31402). Because the Office Action does not make out a proper *prima facie* case of obviousness with respect to claim 1, this rejection should be withdrawn.

The Office Action cites the Robinson reference as teaching all elements of claim 1 except for the claim limitation that the phase change material is used at a basis weight of at least about 100 gsm. While this characterization of the Robinson reference is expressly not agreed with, even if such is indeed the case, the remainder of the Office Action does not properly demonstrate a motivation to modify the reference sufficient to resolve the differences between the prior art and the claimed invention. In fact, the Office Action points to no motivation at all for modifying Robinson's teachings to include the concededly missing element of a phase change material used at a basis weight of least about 100 gsm.

Rather than demonstrate a motivation to modify the reference to supply this missing teaching, the Office Action concludes (on page 2-3)

intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Although this quotation is an accurate statement of the law in appropriate cases, it is misapplied in the instant case with respect to claim 1. The limitation admitted to be missing from the Robinson is not directed to an intended use. It is structural difference between the cited prior art and the claim. In other words the claim limitation that the phase change material "is used at a basis weight of at least about 100gsm" is simply another way of describing how much of the phase change material is present in the

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claimed structure. It is not a limitation directed to how the article is intended to be used - this is so even though the phrase "is used" appears in the claim. In the context given, this words are no different than a phrase such as "is present in an amount." This requirement of a minimum amount of phase change material distinguishes the structure of the claimed article from that taught in the prior art. As such, this claim limitation cannot simply be ignored on the basis that it is supposedly directly to an intended use of the article. When this limitation is considered properly, it is evident that the claimed structure differences from that shown in Robinson. Because the Office Action provides no showing of a motivation to modify Robinson to result in the claimed invention, the rejection of claim 1 should be withdrawn.

Rejections under 35 U.S.C. § 103 over Hasse

Claims 1, 10-11, and 14-16 have been rejected under 35 U.S.C. § 103 as unpatentable over Hasse (US 5,591,146). Because the Office Action does not make out a proper *prima facie* case of obviousness with respect to these claims, the rejections should be withdrawn.

The difference noted in the Office Action between the Hasse reference and Claim 1 is the same as that noted above with respect to the Robinson reference. Namely, the Office Action concludes that Hasse does not teach that the phase change material is used at a basis weight of at least about 100 gsm. The Office Action purports to resolve this difference between the claimed invention and the prior art in the same manner as discussed above with respect to Robinson. Therefore, the discussion above with respect to Robinson is equally applicable to the rejections over Hasse. The recitation of the use of the phase change material at a basis weight of at least 100 gsm is a structural difference between claims 1, 10-11, and 14-15 and the Hasse reference. As such this difference cannot simply be dismissed as directed to an "indented use" which results in no patentable distinction. Therefore, the rejection of Claims 1, 10-11, and 14-15 under 35 U.S.C. § 103 over the Hasse reference should be withdrawn.

Claim 16 is also rejected as unpatentable over the Hasse patent. This rejection is also improper and should be withdrawn. While the Office Action does not identify any particular difference between the Hasse patent and Claim 16, it does conclude that elements 95 and 96 shown in Hasse disclose the claimed thermal cell actuator. This characterization of the Hasse patent, however, is not correct. The Office Action points to

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no evidence or disclosure in the Hasse patent that the device of Hasse includes a thermal cell actuator at all. Elements 95 and 96 are microcapsules containing perfume of two basic types. One type releases perfume upon bursting, the other diffuses perfume upon exposure to air. In neither case is either microcapsule described as being a thermal cell actuator. The instant specification makes clear that a thermal cell actuator must either generate or remove heat – indeed this is consistent with the plain and ordinary meaning of the term “thermal cell.” A microcapsule which simply contains a perfume is not the same as the claimed thermal cell actuator. For at least this reason, the rejection of claim 16 over the Hassc patent should be withdrawn.

Rejection under 35 U.S.C. § 103 over Stewart

Claim 1 has been rejected under 35 U.S.C. § 103 as unpatentable over Stewart (US 5,156,911). Because the Office Action does not make out a proper *prima facie* case with respect to claim 1, this rejection should be withdrawn.

The Office Action identifies several differences between Stewart and claim 1. These include the claim element that the phase change material is used at a basis weight of at least about 100 gsm (which was also the cited difference between claim 1 and each of Hassc and Robinson). Stewart also does not teach the claim elements of a liquid impervious backsheet, and liquid pervious topsheet joined to the backsheet, and an absorbent core disposed intermediate the topsheet and backsheet. Stewart is directed to skin activated temperature sensitive adhesive assemblies. The Office Action cites column 4, line 11 where the invention of Stewart is disclosed as suitable for use in a bandage (such as a Band-Aid®). The Office Action maintains that it is well known in the art that the structure of a bandage encompasses a liquid pervious topsheet joined to a liquid impervious backsheet with an absorbent core disposed there between. No evidence is provided for this assertion.

Even assuming that this modification of Stewart is properly suggested on the basis of the disclosure of a bandage, the use of the phase change material at a basis weight of at least about 100 gsm is not. Stewart says nothing about how or how much of a phase change material should be applied to an article. The Office Action simply dismisses this limitation as directed to an “intended use.” This reasoning is no different from that described above with respect to Hasse and Robinson, and is incorrect for at least the same

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Atty. Docket No. 8414Q
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reasons given above with respect to those references. Therefore, the rejection under 35 U.S.C. § 103 over Stewart should be withdrawn.

Conclusion

In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejection under 35 U.S.C. § 103. Early and favorable action in the case is respectfully requested.

Reconsideration of this application, and allowance of Claims 1 and 10-16 is respectfully requested.

Respectfully submitted,

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